

REMARKS

Amendment to the Claims

Claim 34 has been amended to overcome a typographical error and to insure proper dependency.

Summary of the Official Action

All the claims in the application, namely, claims 22-27, 31-36 and 41-43, have been rejected under 35 U.S.C. 102(f).

The gist of the Official Action is that the references relied upon, Zook et al, U.S. 6,525,168, discloses compositions that read on the instant claims 22-27, 31-34 and 41-42, and the Zook et al reference, U.S. 6,723,827, discloses curable compositions that read on the instant claims 35-36 and 43.

The Official Action points out that the instant application and the cited references have two common inventors, Jonathan D. Zook and Davis (sic) David W. Jordan, and the application has four different inventors. The Official Action queries how the non-common inventors, namely, Susan E. DeMoss, Chandra B. Rao, Hakam Singh, and Ahmed Sharaby, have contributed to the claimed subject matter?

Response to Rejection

The interview granted by Examiners Duc Truong and Christine Tierney to Jerry Voight and William Uhl, attorneys for PRC-DeSoto International, Inc. ("PRC"), the assignee of the instant application, is acknowledged with appreciation. During the interview, some background information was provided to help in understanding the situation. Jonathan D. Zook, Susan E. DeMoss and David W. Jordan were originally employees of PRC. While employed at PRC, they, along with Chandra B. Rao, made the invention as presently set forth in the claims of the

instant application. Jonathan D. Zook, Susan E. DeMoss and David W. Jordan then left the employ of PRC and accepted employment at PBT Brands, Inc. ("PBT"), the assignee of the above two mentioned references. While at PBT the patent applications corresponding to the above two mentioned references were filed. PRC is contending that the invention as claimed in the above two mentioned references was derived from PRC, and specifically the work done by Jonathan D. Zook, David W. Jordan, Susan E. DeMoss and Chandra B. Rao while employed by PRC. Therefore, PRC has, with the filing and prosecution of the instant application, requested an interference with the above two mentioned references so that the derivation issue can be resolved.

During the interview, Ms. Tierney pointed out that in the instance of a potential Interference between applications and patents with both common and different inventive entities, the Patent and Trademark Office (PTO) makes a 35 U.S.C. 102(f) inquiry to ascertain the correct inventive entity for the party requesting the Interference. Accordingly, attached to this response is a Rule 132 Affidavit of Chandra B. Rao, a listed inventor, commenting on his and his co-inventors' (Jonathan D. Zook, Susan E. DeMoss and David W. Jordan) contributions to the claims in the instant application. It is believed that Dr. Rao's Affidavit clearly points out the specific contributions each inventor made to the claims of the instant application. Therefore, it is believed the 35 U.S.C. 102(f) rejection should be withdrawn.

Although the 35 U.S.C. 102(f) rejection should be withdrawn, the rejection has called attention to the inventive entity of the instant application. During prosecution of the instant application, the original claims were cancelled and new claims were added. The claims as originally filed were directed to sealant and potting formulations. As to these claims the inventive entity of Jonathan D. Zook, David W. Jordan, Susan E. DeMoss, Chandra B. Rao,

Hakam Singh, and Ahmed Sharaby was correct. These claims were cancelled and claims directed to polythioethers were substituted. As to the new claims, it is believed that the inventive entity should be Jonathan D. Zook, David W. Jordan, Susan E. DeMoss and Chandra B. Rao. Hakam Singh and Ahmed Sharaby should be deleted as inventors. A request in accordance with 35 CFR 1.48(g) to correct the inventive entity is being filed concurrently with this response.

Conclusion

Based on Dr. Rao's Affidavit, it is respectfully requested that the 35 U.S.C. 102(f) rejection be withdrawn. Further, it is respectfully requested that the claims of the instant application with the corrected inventive entity be held allowable and that an interference be declared with the cited references, that is, U.S. 6,525,168 and 6,723,827. Proposed counts are set forth in Appendix A of Applicants' previous response dated January 13, 2006.

Should this amendment raise any questions, the Examiner is urged to contact Applicants' attorney undersigned below for a telephonic interview to resolve the questions. Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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